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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/902,153	07/29/1997	KEN HASHIMOTO	826.1410/JDH	9897

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EXAMINER

KINCAID, LESTER G

ART UNIT

PAPER NUMBER

2685

DATE MAILED: 09/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

08/902,153

Applicant(s)

HASHIMOTO, KEN

Examiner

Lester G. Kincaid

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 13 February 2002.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 2-9,11-19,21-23,25-27 and 32-37 is/are pending in the application.

4a) Of the above claim(s) 2-9,11-19,21-23,25-27 and 34-37 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 32 and 33 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Newly submitted claims 34-37, 2-9, 11-19, 21-23, and 25-27 are directed to an invention that is independent or distinct from the invention originally claimed (currently represented by claims 32 and 33) for the following reasons:

The inventions are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of claims 32 and 33 has separate utility such as for use with non-telephone specific terminals and/or systems.

See MPEP § 806.05(d).

2. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

3. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 34-37, 2-9, 11-19, 21-23, and 25-27 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 32 and 33** are rejected under 35 U.S.C. 103(a) as being unpatentable over Norris (U.S. Patent 5,689,269) in view of Schuchman et al. (U.S. Patent 5,422,813).

Norris disclose a position information management system and method, comprising:  
an information terminal receiving position information (400/600),  
wherein it was advantageous for the position of a first party holding a first terminal (400/600) to be obtained by a second party holding another terminal (450/610), both positions being displayed on the terminal of the second party - in order to aid the second party in moving toward the first. See col. 5, line 37 through col. 6, line 14. Norris fail to explicitly recite wherein the information terminal receives position

information from a plurality of different kinds of positioning systems - each having its own radio equipment and corresponding waves; and includes

a controller automatically changing from an unavailable positioning system to an available one.

In an analogous art, Schuchman et al. disclose wherein it was known that positioning systems (and specifically GPS) contain areas with gaps in coverage and it was therefore advantageous for an information terminal to receive position information from a plurality of different kinds of positioning systems - each having its own radio equipment and corresponding waves and to include a controller for automatically changing from an unavailable positioning system to an available one. See col. 1, lines 18-53, col. 2, lines 4-60, col. 3, lines 1-22, col. 4, lines 17-22, and col. 5, lines 33-55. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the terminals of Norris such that they would be able to receive position information from a plurality of different kinds of positioning systems - each having its own radio equipment and corresponding waves and to include a controller for automatically changing from an unavailable positioning system to an available one, as taught by Schuchman et al. for the purpose of filling in the coverage gaps inherent to a positioning system.

### ***Response to Arguments***

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Usui (U.S. Patent 6,414,630) and Sass (U.S. Patent 5,317,321) additionally, each provide for terminals for displaying the position of both parties.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lester G. Kincaid whose telephone number is (703) 306-3016. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 Customer Service Office at (703) 306-0377.

**Any response to this final action should be mailed to:**

**Box AF**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9314 (TC 2600 only)  
(for formal communications; please mark "EXPEDITED PROCEDURE")  
(for informal or draft communications, please label "PROPOSED" or  
"DRAFT" and mark "PLEASE DELIVER TO EXAMINER")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

LGK  
September 23, 2002



LESTER G. KINCAID  
PRIMARY EXAMINER